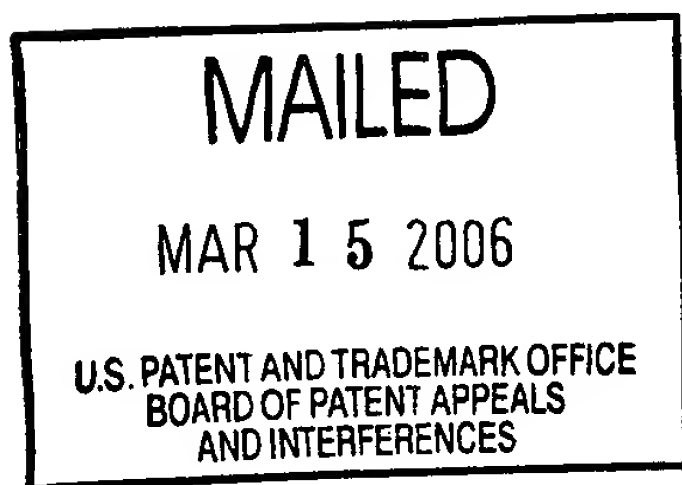


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte FREDERIC BAUCHOT,
DANIEL MAUDUIT and ALBERT HARARI

Appeal No. 2006-0533
Application 09/838,420

ON BRIEF

Before THOMAS, SAADAT, and MACDONALD, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 through 11.

Representative claim 1 is reproduced below.

1. A method, implemented on a computer system, for processing user defined Boolean variables in a multi dimensional spreadsheet (200) comprising a plurality of cells identified by a cell address along each dimension, said method comprising the steps of:

defining one or a plurality of Boolean variables in a table (400), whereby said Boolean variables are managed;

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referencing said one or plurality of Boolean variables in one or a plurality of cells; and

determining the content of said cell or plurality of cells;

wherein each of said Boolean variables can be set as "True" or "False," and impact the content of a cell within an electronic spreadsheet.

The following references are relied on by the Examiner:

Kelly, Julia, Using Microsoft Excel 97, 3rd Edition, Que Corp., Indianapolis, IN (c) 1998, pp. 124-131, 138-144, 154-189, 209-210, 337-343, 561 and 563.

Deitel, H.M., et al., C++: How to program, 2nd Edition, Prentice Hall, Upper Saddle River, NJ, (c) 1994, pp. 10, 106-110, 147, 243-244, 256-262, 448, 473-479, 483-485, 707-730, 981-987 and 1043-1045.

Microsoft Computer Dictionary, 4th Edition, Microsoft Press, Redmond, WA, (c) 1999, pp. 29, 56-58, 79, 229, 272, 420 and 434.

Claim 11 stands rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite. This claim is also rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Finally, claims 1 through 11, all claims on appeal, stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Kelly in view of Deitel, further in view of the Computer Dictionary.

Rather than repeat the positions of the appellants and the examiner, reference is made to the Brief and Reply Brief for

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appellants' positions, and to the Answer for the examiner's positions.

OPINION

Because we regard all claims on appeal, claims 1 through 11, as both fatally indefinite under the second paragraph of 35 U.S.C. § 112 and subject to rejections for non-statutory subject matter within 35 U.S.C. § 101, the examiner's rationale to reject only claim 11 under both of these bases is expanded upon and encompassed by our reasoning which follows. We therefore denominate the following as new grounds of rejection within 37 CFR § 41.50(b).

Claims 1 through 11 are rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite. From our study of independent claim 1 on appeal, it appears that there is a significant disconnect between the elements set forth in the preamble of this method claim and the subject matter of the body of this claim. There is no positively stated but only at most an inferential implementation of the claimed invention on a computer system. The end of claim 1 merely recites "an electronic spreadsheet" and not the spreadsheet of the preamble. Similarly, the one or plurality of cells in the body of the claim is not

recited to be one or a plurality of cells of the identified spreadsheet in the preamble. The "table" is not stated to be in a memory of the computer system. There is only at most an inferential statement of managing the Boolean variables. The nature of the meaning of the word "managed" is not defined as is the word "defining" itself. Likewise, the broad use of the word "referencing" in the body of the claim has no operative relationship or has a questionable scope as to the meaning of the term. Significantly, the words "can be set" are not a positive statement of anything and appear to relate only to a future act that may or may not ever occur. Additionally, the fact, as recited, that the variables "can be set" as true or false does not recite accurately all conditions, which include, as claimed, the condition of the absence of a true and false setting being set; neither being set is also a condition. Additionally, the scope of meaning of the word "impact" is not determinable as well. Overall, it may be fairly stated that the metes and bounds of independent claim 1 on appeal cannot reasonably be determined.

When we turn to the dependent claims, the claimed "the status value" of dependent claim 3 is not initially recited in parent independent claim 1 from which it depends. The same may

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be said of "the name" in claim 5, the claimed "a status value" in claim 6, and the corresponding "the status value" in claim 7.

The reference of "said steps" in claim 8 is not recited in parent independent claim 1 from which it directly depends. Claim 9 recites the display on a screen of "a computer system" but does not specify that it is the claimed computer system in the preamble of independent claim 1. It appears that this may be a part of another unstated computer system.

Independent claim 10 is rejected for the same reasons as set forth with respect to independent claim 1.

As to claim 11, this claim is indefinite because it cannot be determined if it is to be construed as an independent claim on its own or whether it is in fact merely a dependent claim from claim 1. In the latter case, since independent claim 1 is a method claim, on its face, its dependent claim 11 may be purported to comprise a structure claim. Therefore, it is not clear whether claim 11 is in fact a method or an apparatus claim. The claimed "medium" is merely stated to be "computer-usable" and not actually used in a computer system. This computer is not stated to be the computer system of the preamble of claim 1.

Continuing our discussion with respect to claim 11, the nature of the arguments presented by appellants at page 7 of the principal Brief on appeal lead us to further conclude that the use of the terms "computer-usable medium" is intended by appellants to have no limit of the concepts of which the artisan may construe these terms. Therefore, the arguments made by appellants to prove or urge definiteness in fact argue that claim 11 is indefinite. Because the arguments in the Brief and Reply Brief intend to significantly expand upon the scope of the nature of the use of the conventional meaning of "computer-usable medium" with respect to figure 1A in the disclosed invention well beyond the mass storage element 107 and the main memory 102, the arguments as well in the Reply Brief are unpersuasive of definiteness. The use of the terms "computer-usable medium" are intended to have such a broad meaning by appellants that the metes and bounds of claim 11 is not reasonably determinable in the context of an independent claim or in the context of being dependent upon independent claim 1. Since there are no computer readable instructions per se that are disclosed, the scope of meaning to be attributed to these terms in claim 11 itself is also not determinable.

We also expand the examiner's rejection of claim 11 under 35 U.S.C. § 101 to include all claims on appeal, claims 1 through 11. In view of the nature of the positions we have set forth earlier with respect to the way we view method independent claim 1 on appeal, this claim essentially sets forth an abstract intellectual concept or data construct of mathematical/Boolean variables that are set forth in the abstract around the concept of a table. There is such a significant analytical disconnect between the subject matter that is conventional structure in the art in the preamble and that which is specifically recited in the body of the method independent claim 1 on appeal as to clearly indicate that even independent claim 1 as a whole, and its corresponding independent claim 10 are directed to nonstatutory subject matter per se. At least with respect as well to the so-called system independent claim 10, there is no corresponding means disclosed in the structural or even in the programming instruction sense to correspond to the claimed means elements in this claim. The dependent claims further refine the abstract concepts of independent claim 1 to include the concept of names, status values, the actual computation of a data value, the ability to change or otherwise alter any of these variables, and

the use of the abstract concept of true and false. As recited, claim 11 appears to plainly state that the claimed "computer-usable medium" is itself comprised of the claimed "computer readable instructions" per se. Conversely, this claim does not require or recite a positive statement of a computer readable medium in the conventional sense in the art within which is embodied computer readable instructions. That is, there is no embodiment of computer readable instructions on a tangible computer readable medium.

The examiner's view at page 6 as to the rejection of claim 11 under 35 U.S.C. § 101 that the claimed "computer usable medium" encompass an intangible embodiment such as carrier waves or transmission media would appear, at first blush, to be somewhat preposterous. On the other hand, appellants' responsive arguments as to the second rejection of this claim under the second paragraph of 35 U.S.C. § 112 make clear that appellants intend these to be encompassed by the term. This is simply seen because the use of the term "computer-usable medium" in claim 11 does not positively state that any kind of medium is actually used.

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In light of these new rejections, we pro forma reverse the outstanding rejection of claims 1 through 11 under 35 U.S.C. § 103 because the subject matter encompassed by these claims on appeal must be reasonably understood without resort to speculation to apply prior art to them. Note In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). Note also In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). It is important to note that the reversal of the outstanding art rejection under 35 U.S.C. § 103 should not necessarily be construed as a reversal of the rejection on the merits. The prior art relied upon by the examiner appears to be pertinent to the disclosed invention and may in fact be pertinent to properly definite claims within 35 U.S.C. § 112 as well as claims that meet 35 U.S.C. § 101. Therefore, the examiner is free to choose to reinstitute during future prosecution the present rejection under 35 U.S.C. § 103 and/or utilize any additional or different prior art.

In view of the foregoing, we have essentially affirmed the examiner's rejection of claim 11 under 35 U.S.C. § 112, second paragraph, and the separate rejection of this claim under 35 U.S.C. § 101 and, in the process, extended these rejections

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within 37 CFR § 41.50(b) to all claims on appeal, claims 1 through 11. We have pro forma reversed the rejection of claims 1 through 11 under 35 U.S.C. § 103. Therefore, the decision of the examiner is affirmed-in-part.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that the appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

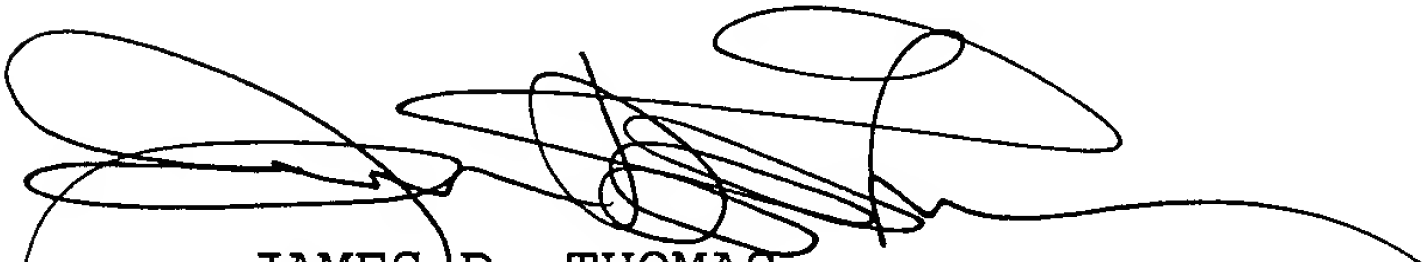
(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

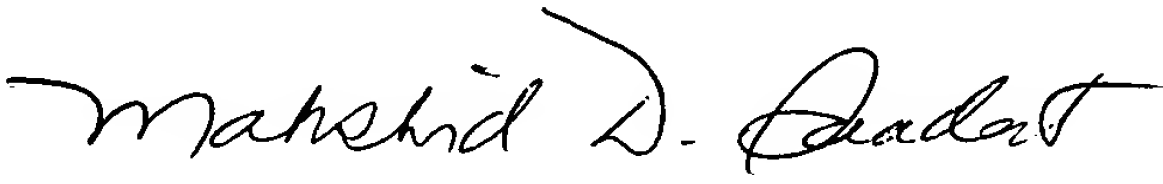
(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART 37 CFR § 41.50(b)


JAMES D. THOMAS
Administrative Patent Judge


MAHSHID D. SAADAT
Administrative Patent Judge


ALLEN R. MACDONALD
Administrative Patent Judge

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